

### **REMARKS**

Applicant hereby traverses the current rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-25, 27-28, 40, and 42-43 have been canceled without prejudice. Claim 34 stands withdrawn from consideration. Claims 26 and 29-39 are pending in this application.

#### **Restriction Requirement**

Applicant notes that claims 26, 29-33, and 35-39 remain from elected Group I. Claim 34 is drawn to the non-elected species B, and thus stands withdrawn. However, Applicant respectfully reminds the Examiner that should claim 29 be allowed, claim 34 should be allowed as well.

#### **Rejection Under 35 U.S.C. § 112**

Claims 7 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for a lack of antecedent basis. As this claim has been canceled, Applicant respectfully asserts that this rejection is moot, and should be withdrawn.

#### **Rejection Under 35 U.S.C. § 102**

Claims 1-3, 7-11, 13, 21, 25-27, 29, and 35-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Millot et al. (US '853, hereinafter Millot).

With respect to claims 1-3, 7-11, 12, 21, 25, and 27, as these claims have been canceled, Applicant respectfully asserts that the rejection of these claims is now moot, and should be withdrawn.

With respect to claims 26, 29, and 35-36, it is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15

U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least one of these requirements.

Claim 29, as amended, defines a device for treating tissue, and includes a control unit adapted to pass alternating current to the treatment area via the electrodes and is further adapted to vary constantly the amplitude and/or the frequency of the alternating current. Millot does not disclose at least these limitations. More specifically, Millot does not disclose passing alternating current to the treatment area. Millot appears to be using direct current, which is different from the claimed alternating current, see column 5, lines 19-37 of Millot. Furthermore, Millot does not disclose constantly varying either the amplitude or frequency of the alternating current. Millot is silent as to any variation of the either the amplitude or the frequency of the alternating current, as well as being silent at to constant variation of the amplitude or the frequency of the alternating current. Thus, Millot does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 29 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 26 and 35-36 depend from base claim 29, and thus inherit all limitations of claim 29. Each of claims 26 and 35-36 sets forth features and limitations not recited by Millot. Thus, the Applicant respectfully asserts that for the above reasons claims 26 and 35-36 are patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, claim 36 defines that the electronic circuitry of the device stores at least one programme for determining the amplitude, frequency and waveform of alternating current supplied to the electrodes. As Millot is silent as to alternative current, Millot cannot disclose a programme for determining the amplitude, frequency and waveform of the alternating current. Thus, Millot does not teach all of the claimed limitations. Therefore, the Applicant respectfully

asserts that for the above reasons claim 36 is patentable over the 35 U.S.C. § 102 rejection of record.

**Rejection Under 35 U.S.C. § 102**

Claims 1-3, 21, 29-30, 32-33, and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Claude (US '742).

With respect to claims 1-3 and 21, as these claims have been canceled, Applicant respectfully asserts that the rejection of these claims is now moot, and should be withdrawn.

With respect to claims 29-30, 32-33, and 35, it is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least one of these requirements.

Claim 29, as amended, defines a device for treating tissue, and includes a control unit adapted to pass alternating current to the treatment area via the electrodes and is further adapted to vary constantly the amplitude and/or the frequency of the alternating current. Claude does not disclose at least these limitations. More specifically, Claude does not disclose that the control unit varies constantly the amplitude and/or the frequency of the alternating current. Claude does discuss selecting an amplitude and frequency from particular ranges, but once selected, the amplitude and frequency are fixed and cannot be changed. See column 4, lines 14-17, wherein the characteristics are determined by the values of R2, R3, and C1 in accordance with the manufacture's specifications. Consequently, Claude is silent as to any variation of the either the

amplitude or the frequency of the alternating current, as well as being silent as to constant variation of the amplitude or the frequency of the alternating current. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 29 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 30, 32-33, and 35 depend from base claim 29, and thus inherit all limitations of claim 29. Each of claims 30, 32-33, and 35 sets forth features and limitations not recited by Claude. Thus, the Applicant respectfully asserts that for the above reasons claims 30, 32-33, and 35 are patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, claim 30 defines a device that has the alternating current is varied between 50 and 500 microamps. As Claude is silent as to varying the amplitude or frequency of the alternative current, Claude cannot disclose varying the current in the claimed range. Claude does disclose selecting a current, but does not disclose varying the current in the claimed range. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 30 is patentable over the 35 U.S.C. § 102 rejection of record.

Still furthermore, claim 32 defines a device that has the time period between each variation of amplitude and/or frequency be 0.1s. As Claude is silent as to varying the amplitude or frequency of the alternative current, Claude cannot disclose having the time period between variations be at the claimed value. Claude does disclose having a particular frequency, but this does not disclose having the variations occur at the claimed value. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 32 is patentable over the 35 U.S.C. § 102 rejection of record.

Still furthermore, claim 33 defines a device that has the alternating current have a ramp waveform. The Office Action cites Figure 5 of Claude as teaching a ramp waveform. However, as shown, the waveform is not a ramp but rather is a series of pulses, where the current moves from 0 to the selected value instantaneously. Thus, Claude does not teach all of the claimed

limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 33 is patentable over the 35 U.S.C. § 102 rejection of record.

**Rejections Under 35 U.S.C. § 103**

Claims 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Scherson et al. (US '570, hereinafter Scherson).

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Lee (US '460).

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot.

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Yavnai (US Application 2003/0176825).

With respect to claims 4-6, 12, and 14-15, as these claims have been canceled, Applicant respectfully asserts that these rejections are now moot, and should be withdrawn.

**Rejection Under 35 U.S.C. § 103**

Claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Claude.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be shown by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combination fails to teach multiple claim limitations as asserted by the Office Action, Applicant respectfully submits that the present rejections are improper.

Base claim 29 is defined as described above. Claude does not teach all limitations of claim 29 as described above. The modification introduced with respect to claim 31 does not overcome the deficiency in teaching all of the limitations of claim 29. Therefore, the modification of Claude does not teach all elements of the claimed invention of claim 29.

Claim 31 depends from base claim 29, and thus inherit all limitations of claim 29. Claim 31 sets forth features and limitations not recited by the modification of Claude. Thus, the Applicant respectfully asserts that for the above reasons claim 31 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Furthermore, claim 31 defines a device that has the frequency of the alternating current is varied between 10 and 900 hertz. As Claude is silent as to varying the amplitude or frequency of the alternative current, Claude cannot disclose varying the frequency in the claimed range. Claude does disclose selecting a frequency, but does not disclose varying the frequency in the claimed range. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 31 is patentable over the 35 U.S.C. § 103 rejection of record.

### **Rejections Under 35 U.S.C. § 103**

Claims 37-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Jacobsen (US '957).

Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot and Jacobsen in view of Claude.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be shown by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combinations fail to teach multiple claim limitations as asserted by the Office Action, Applicant respectfully submits that the present rejections are improper.

Base claim 29 is defined as described above. Millot does not teach all limitations of claim 29 as described above. The combinations of Millot and Jacobsen, and Millot, Jacobsen, and Claude introduced with respect to claims 37-39 do not overcome the deficiency in teaching all of the limitations of claim 29. Therefore, the various combinations of record do not teach all elements of the claimed invention of claim 29.

Claims 37-39 depend from base claim 29, and thus inherit all limitations of claim 29. Claims 37-39 set forth features and limitations not recited by the various combinations of record. Thus, the Applicant respectfully asserts that for the above reasons claims 37-39 are patentable over the 35 U.S.C. § 103(a) rejections of record.

### **Conclusion**

Claims 26, 29, and 35-36 have also been amended to more properly define the invention claimed therein. The claims have been amended only for this purpose, and not for the purpose of narrowing their scope in the face of prior art. Claims 34 and 38-39 have been amended to change their dependencies. No new matter has been added by these amendments.

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 51407/P029US/10605267 from which the undersigned is authorized to draw.

Dated: September 22, 2008

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: September 22, 2008

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Joy H. Perigo

Respectfully submitted,

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